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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,218	08/21/2001	Che-Kuang Wu	C002-1001B	7997
20985	7590	07/13/2004	EXAMINER	
FISH & RICHARDSON, PC			YOUNG, CHRISTOPHER G	
12390 EL CAMINO REAL			ART UNIT	
SAN DIEGO, CA 92130-2081			PAPER NUMBER	

1756

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,218

Applicant(s)

WU, CHE-KUANG

Examiner

Christopher G. Young

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-7, 9-12, 14-17, 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-4, 8 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1756

DETAILED ACTION

1. This Office Action is responsive to the Appeal Brief filed 12-24-2003. The Examiner is issuing the following Non-Final rejection to clarify the many issues of the proposed Appeal. The prior art rejection of record, made FINAL in the previous Office Action, is withdrawn in its previously presented form and the following action stands in its place.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 8 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al.

Applicants have copied the claims of the Lee reference, proposing an INTERFERENCE with said reference. Upon a careful review of the instant application's parent history, going back to the Provisional Application 60030258, filed 10-31-1996, the Examiner has determined that claims 1-4, 8 and 13 do not find express support of the type needed to provide entitlement of this date. In view of this, these claims are rejected as anticipated.

Claim 1 contains a listing of substrates including quartz glass, silicate glass, germanium and optically transmissive material to be coated with the photoresist layer. The Provisional Application only discusses silicate glasses as useful substrates. In view of this, claim 1 and its dependents (claims 2-4) do not have enabling disclosure in the Provisional Application. Additionally, claim 2 lists 25 nA as the current of the electron beam and this specific number does not find basis in the Provisional Application. Particularly this number has no basis as being set for a lower limit of "at least" 25 nA.

Claim 8 does not have enabling disclosure in the Provisional Application for the presented lower limit of acceleration voltage being "at least 20 kV".

Claim 13 does not have enabling disclosure in the Provisional Application for the presented lower limit of electron beam current being "at least 25 nA".

Allowable Subject Matter

5. Claims 5-7, 9-12, 14-17, 19 and 20 are allowed. These claims do find basis in the Provisional Application and are entitled to that filing date. In view of this fact the reference to Lee et al. is antedated with respect to these claims.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher G. Young whose telephone number is 571-272-1394. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark F. Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Chris G. Young', with a stylized flourish at the end.

Christopher G. Young
Primary Examiner
Art Unit 1756

cgy